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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

99\_1229A

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Application Number

09/436,656

Filed

11/09/1999

First Named Inventor

KENJI TAGAWA

Art Unit

3627

Examiner

Gerald J. O'Connor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☐ attorney or agent of record.  
Registration number \_\_\_\_\_☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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August 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 6961**  
Kenji TAGAWA et al. : Docket No. 99\_1229A  
Serial No. 09/436,656 : Group Art Unit 3627  
Filed November 9, 1999 : Examiner G. J. O'Connor  
  
DATA CONVERSION APPARATUS **Mail Stop: AF**  
AND METHOD IN COPYRIGHT  
PROTECTING SYSTEM

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEES FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975

Sir:

This is a pre-appeal brief request for review of the rejection of claims 22-24, 26-28 and 43-48 as set forth in the Official Action dated April 7, 2005.

## **REMARKS**

This is a pre-appeal brief request for review of the rejection of claims 22-24, 26-28 and 43-48 as set forth in the Final Office Action dated April 7, 2005. No amendments are being filed with this request. This request is being filed concurrently with a Notice of Appeal and a petition for a one month extension of time.

Claims 22-24, 26-28 and 43-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Imai et al. (U.S. 5,870,467). The request for review of this rejection is based on the following:

### **I. The Examiner has not addressed all of the features recited in the claims**

Claim 22 recites that “in a case where said data format judging section judges that the received data is not of the superdistribution format, said controller controls said attribute information obtaining section so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controller controls said data format conversion section so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus.”

It is respectfully submitted that the Examiner has not addressed this feature of claim 22 despite explicit requests for the Examiner to do so, as well as repeated arguments that Imai does not disclose or suggest such a feature (see Amendment filed on January 13, 2005 at pages 23-24.

A brief summary of the Imai reference is provided as follows. Imai discloses an input/output requesting program 11, a data input/output request reception unit 1 for receiving data input/output requests from the program 11, a data input unit 2 for entering data into the program 11 and a data output unit for outputting data from the program 11 (see Figs. 1 and 25; and col. 8, lines 18-34).

When a data input request is received by the input/output request reception unit 1, the data input unit 2 enters the requested data and the protected data judgement unit 3 judges whether the data entered into the program 11 is considered protected data (see col. 8, line 65 - col. 9, line 9). If the data is determined to be protected by the data judgement unit 3, a record of the input is made in

the protected data input recording unit 4 by storing an ID of the requesting program 11 in the protected data input recording unit 4 (see col. 9, lines 42-55). In contrast, if the data is not determined to be protected, then no record is made in the protected data input recording unit 4 (see col. 9, lines 45-48).

When a data output request is received at the input/output request reception unit 1, an output permission judgment unit 5 checks whether the ID of the requesting program 11 is stored in the protected data input recording unit 4 (see col. 10, lines 10-16). If the ID is not stored in the protected data input recording unit 4, then the data is output (see col. 10, lines 16-20). However, if the ID is stored in the protected data input recording unit 4, this implies that the requesting program 11 has previously read protected data, and therefore, further steps are taken to determine whether the data can be output (see col. 10, lines 22-32).

Thus, as is evident from the above description, while Imai discloses the ability to detect protected data and prevent such data from being improperly output, Appellants respectfully submit that Imai does not disclose or even remotely suggest the above-discussed feature recited in claim 22. Appellants note that independent claim 43 recites the same feature as discussed above with respect to claim 22.

## **II. The Examiner has clearly misinterpreted the operation of the “output permission judgement unit 5” of Imai**

Claim 22 recites the feature of “a data format conversion section adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format.”

In the Office Action, the Examiner alleges that the output permission judgement unit 5 of Imai corresponds to the data format conversion unit as claimed (see Final Office Action at page 4). As explained above, the output permission judgement unit 5 of Imai is responsible for checking whether or not the received data is protected data, and if the data is not protected data, the output permission judgement unit 5 allows the data to be output (see col. 10, lines 10-20).

The output permission judgement unit 5, however, is in no way whatsoever capable of adding ciphered attribute information and identification information to audio contents and thereby converting the audio contents together with the obtained attribute information to the

superdistribution format, as recited in claim 22. Instead, the output permission judgement unit 5 of Imai is merely able to determine whether data can be output or not.

It is noted that the Examiner has not responded to repeated arguments that Imai does not disclose or suggest the above-noted feature (e.g., see Amendment filed January 13, 2005 at pages 22-23. Appellants maintain the position that Imai clearly fails to disclose or suggest such a feature.

### **III. The Examiner has not interpreted the means-plus-function limitations in claims 43-48 in accordance with the requirements set forth in the MPEP**

Regarding claims 43-48, it is noted that these claims are similar to claims 22-24 and 26-28 but are written in means-plus-function format.

In the Final Office Action, the Examiner asserts that claims 43-48 are written in means-plus-function format, but that the intended usage recited in these claims “need not be explicitly disclosed in the reference if the claimed structure, as disclosed in the reference, is inherently capable of performing the claimed usage” (see Final Office Action at page 10, item 22).

In other words, the Examiner does not believe that a prior art reference must disclose the identical function recited in the means-plus-function limitation. Instead, the Examiner believes that the structure in the prior art must merely be capable of performing the specified function in the means-plus-function limitation. Appellants disagree.

In particular, Appellants note that MPEP § 2182 sets forth the following with respect to the “functional” portion of means-plus-function limitations:

Both before and after *Donaldson*, the application of a prior art reference to a means or step plus function limitation **requires that the prior art element perform the identical function specified in the claim** (emphasis added).

Thus, as is clear from the MPEP, it is necessary that the prior art structure perform the identical function recited in the means plus function limitation, and if the identical function is not performed, then the prior art cannot be considered anticipatory. Thus, the Examiner’s position that

a prior art structure must merely be inherently capable of performing the specified function is clearly incorrect based on the requirements set forth in the MPEP.

In view of the foregoing, Appellants respectfully submit that the structure in Imai does not perform the identical functions recited in the "means-plus-function" limitations of claim 43. For specific examples of the means-plus-function limitations which Imai does not disclose or suggest, please see the Amendment filed on January 13, 2005 at page 30.

#### **IV. Conclusion**

In view of the foregoing, Appellants respectfully submit that independent claims 22 and 43 are patentable over Imai, as well as all claims that depend therefrom. Accordingly, reconsideration of the rejection set forth in the Final Office Action is respectfully requested.

Respectfully submitted,

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